



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/058,840	04/13/98	WALKER	J 3178-4021US1

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PM52/0616

EXAMINER

LAUFER, F

ART UNIT

PAPER NUMBER

3642

5

DATE MAILED: 06/16/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/058,840</b>	Applicant(s) <b>Walker et al.</b>
	Examiner <b>703 306 4160</b> <b>Pinchus M. Laufer</b>	Group Art Unit <b>3642</b>



Responsive to communication(s) filed on May 18, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-96 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-96 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 & 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **Part III DETAILED ACTION**

#### ***Claim Rejections - 35 U.S.C. § 112***

1. Claims 1-96 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As applicant points out, exactly what constitutes a legally binding contract within the context of electronic commerce is not yet resolved. Therefore, the claims are indefinite.

**Claims 69 and 71:** The phrase "anonymously includes" on line 2 is unclear.

**Claims 71 and 72:** The phrase "anonymous mix protocol" has no support in the specification and is therefore indefinite as it is not clear what is meant.

#### ***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 13-24, 27, 28, 33-37, 41, 43-52, 54-56, 66-68, and 73-82, 84-88, 90-96 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the Marketel system described in the 5th non-patent reference of the IDS of 13 April 1998 [hereinafter referred to as C5].

4. Claims 1-10, 13-24, 28-30, 33-39, 43-52, 54-56, 66-68, and 73-96 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shavit et al. ('156). The multiple sellers on the system have access to the purchase requests of each buyer. with respect to dispute resolution (claims 86-88) the central processor's database of transaction history provides the data for dispute resolution.

5. Claims 1-10, 13-24, 27-30, 33-39, 43-52, 54, and 89-96 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by conducting business through an agent using telephone and/or fax. The biometric authentication step (claims 24 and 27) can be either voice or signature.

6. Claims 1-10, 13-24, 28-30, 33-39, 43-52, 54-56, 66-68, 73-82, 84, 85, and 89-96 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Wiseman ('446).
7. Claims 46 and 49-52 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Kurland et al. ('222).
8. Claims 46 and 49-52 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Kelly et al. ('186).
9. Claims 46 and 49-52 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Yuris et al. ('759).
10. Claim 90 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by on-line merchandise wanted classified ads as exemplified by Reference "R".

***Claim Rejections - 35 U.S.C. § 103***

11. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

12. Claims 1-96 are rejected under 35 U.S.C. § 102(e) as anticipated by Rosen ('158) or, in the alternative, under 35 U.S.C. § 103 as obvious over Rosen ('158) in view of Reference C5 of the IDS. Rosen teaches all the features of the claims except the buyer's offer being available to multiple prospective sellers. There is no inherent difference between a buyer and seller that would not allow them to switch roles within the context of Rosen's invention. Therefore, the buyer's offer being available to multiple sellers is encompassed within Rosen. In the alternative, that the difference between a buyer and seller is significant so that they are not equivalent within the context of Rosen, C5 teaches the buyer's offer being presented to multiple

suppliers. This feature is motivated by the desire to afford individual buyers more power in the marketplace. In light of C5's teaching it would have been obvious to implement Rosen with this additional feature.

13. Claims 11, 12, 25-27, 31, 32, 40, 42, 53, 57-65, and 69-72 are rejected under 35 U.S.C. § 103 as being unpatentable over Shavit. Shavit teaches authorization and security measures. In light of that teaching, it would have been obvious to implement any of the well known cryptographic devices of these claims to ensure the integrity of the transaction and/or to provide privacy to the transacting parties.

14. Claims 11, 12, 25-27, 31, 32, 40, 42, 53, 57-65, and 69-72 are rejected under 35 U.S.C. § 103 as being unpatentable over Wiseman. It would have been obvious to implement any of the well known cryptographic devices of these claims to ensure the integrity of the transaction and/or to provide privacy to the transacting parties.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

#### *Claim Objections*

16. The ordering of the claims is objected to as containing intervening claims between independent claims and the claims that depend therefrom. This is not in accordance with 37 C.F.R. § 1.75(g) which states:

(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible.

The claims should be renumbered to conform with 37 C.F.R. § 1.75(g) prior to allowance.

#### *Drawings*

17. The formal drawings have been forwarded to drafting for review. When the PTO-948 is issued by drafting it will be placed in the file and a copy will be forwarded to the applicant with the next office communication.

#### *Information Regarding Communication with the PTO*

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

Serial Number: 09/058,840

- 5 -

Art Unit: 3642

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. T. Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

June 12, 1998

*Pinchus M. Laufer*

**Pinchus M. Laufer**

**Art Unit 3642**